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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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David J. Danitz

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EXAMINER

NGUYEN, TUAN VAN

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/679,103	Applicant(s) DANITZ ET AL.	
	Examiner TUAN V. NGUYEN	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50-62 and 64-68 is/are rejected.
- 7) ☒ Claim(s) 63 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 50-68 are pending in this application. Claims 50-62 and 64-68 were rejected and claim 63 was objected in the Office Action mailed out on 6 February 2009.

Reopening of Prosecution After Appeal

2. In view of the appeal brief filed on 17 June, 2009, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below:

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Response to Applicant's Arguments

3. Applicant's arguments in the Appeal Brief filed on 17 June, 2009 have been fully considered and persuasive. However, upon further search and consideration claims 50-62 and 64-68 are rejected in view of new ground of rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 50-60 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The cable is critical or essential to the practice of the invention, but not included in the claims is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Without the cable, the plurality of beads positioned next to each other does not function as a shaft.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 50-60 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted element is the cable. Without the cable, the plurality of beads positioned next to each other does not function as a shaft.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 50-60 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peng et al. (U.S. 6,730,020) in view of Larson et al. (US 4,393,728).**

9. Referring to **claims 50, 51, 54-56, 59, 60 and 68**, Peng et al show (see Figs. 1 and 35-38) an articulate column 4B (Fig. 1), that is capable for use as a shaft with a surgical clamp device, comprises a cable or central member and alternating first beads 350 and second beads 340. The second beads 340 have a larger inner diameter than the first beads 350 and each of the second beads is supported on

the outer surface of the first beads 350 wherein the second beads 340 contact adjacent first beads 350 along the shoulder 342 (Fig. 36) to form a line of contact between first bead 350 and second bead 340 (see col. 25, lines 15-45). Peng et al does not specifically disclose the shoulder 342 of the second beads 340 is a convex surface. However, Larson et al disclose the outer surface of the beads 11 of an articulate column should be curved and convex to improve the rolling motion in relation to each other (see col. 2, lines 35-36 and lines 43-45). Apparently, the advantages are providing a greater range of mobility along the length of the shaft, more flexibility to the shaft in order to reach the location that is difficult to get to, and high torsional resistant as suggested by Peng/Larson. It would have been obvious to one of ordinary skill in the art to provide a convex surface to the shoulder 342 of beads 340 as disclosed by Peng et al. so that it too would have the same advantage.

10. As to the recitation that the shaft is for use with a clamp device, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

11. Referring to **claims 52, 53, 57, and 58**, Peng as modified by Larson does not show the second beads has a smaller outer diameter than each of the first beads or has a larger outer diameter as each of the first beads. It would have been an obvious matter of design choice to one of ordinary skill in the art to design an outer

diameter of the second beads smaller or larger than the first beads since such a design does not solve any stated problem.

12. **Claims 61, 62, and 64-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cosgrove, III et al (U.S. 6,139,563) in view of Peng et al. (U.S. 6,730,020) and further in view of Larson et al. (US 4,393,728).**

13. Referring to **claims 61, 62, 64 and 67**, Cosgrove shows a clamp comprising a handle assembly 12, a gripping assembly 16, which includes a pair of jaws 48, and a shaft assembly 14. The shaft assembly has a flexible shaft, wherein the shaft having a proximal end coupled to the handle assembly and a distal end coupled to the gripping assembly. The flexible shaft defines a bore and comprises a plurality of beads 38. A cable 31 extends through the bore and has a proximal end coupled to the handle assembly and a distal end coupled to the gripping assembly.

Cosgrove does not show the beads comprising alternating first and second beads wherein the second beads have a larger inner diameter than the first beads and each of the second beads is supported on the surface of the two adjacent beads at a line of contact and each of the second beads has a convex shape at the line of contact. As already established in the rejection of claims 50-60 and 68 above, Peng as modified by Larson provide an articulable column that is capable for use with a clamp device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the bead formation of Cosgrove with the modified bead formation taught by Peng/Larson, because this will provide a greater range of mobility along the length of the shaft, more flexibility to the shaft in

order to reach the location that is difficult to get to, and high torsional resistant as suggested by Peng/Larson (col. 2, lines 35-36 and 43-45).

14. Referring to **claims 65 and 66**, the modified device of Cosgrove do not show the second beads has a smaller outer diameter than each of the first beads or has larger outer diameter as each of the first beads. However, Examiner contends that it would have been an obvious design choice to one of ordinary skill in the art to design an outer diameter of the second beads smaller or larger than the first beads since such a design does not solve any stated problem.

Allowable Subject Matter

15. Claim 63 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN V. NGUYEN whose telephone number is (571)272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, AnhTuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/T. V. N./
Examiner, Art Unit 3731

/Anh Tuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731
9/16/2009